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OCT 21 2004

In re Application of :  
Charles L. Edwards et al :  
Application No. 10/679,126 :  
Filed: October 3, 2003 :  
Attorney Docket No. TH1647 03 (US) :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition, filed October 19, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition under 37 CFR 1.313(c)(2) is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on September 20, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>**

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center Art Unit will consider the request for continued examination under 37 CFR 1.114.

*Karen Creasy*  
Karen Creasy  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).



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Application No. 10/679,126	:	ON PETITION
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This is a decision on the petition under 37 CFR 1.78(a)(3), filed October 19, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of prior-filed nonprovisional Application No. 10/025,080, filed December 19, 2001.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR 1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to prior-filed nonprovisional Application No. 10/025,080, filed December 19, 2001.

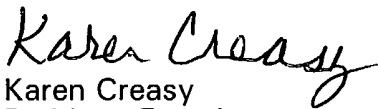
The instant pending nonprovisional application was filed on October 3, 2003, and was pending at the time of filing of the instant petition. While a reference to the prior-filed nonprovisional application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2). However, on the other hand, if the USPTO does not note the claim for priority to the nonprovisional application in the oath or declaration or transmittal letter submitted

with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3).<sup>1</sup> In the instant case, the Office noted the claim for priority of nonprovisional Application No. 10/025,080 in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt.

Any questions concerning this decision on petition may be directed to Karen Creasy at (571) 272-3208. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The examiner of Technology Center AU 1621 will consider the amendment filed with the instant petition, and for consideration by the examiner of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) for the benefit of the prior-filed nonprovisional Application No. 10/025,080, filed on December 19, 2001.



Karen Creasy  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>1</sup> Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.